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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YEHUDA BINDER

Appeal 2016-000622
Application 12/358,551
Technology Center 2600

Before BRUCE R. WINSOR, ADAM J. PYONIN, and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

SZPONDOWSKI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–6, 9–138, 140–162, and 164–168, constituting all claims currently pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

STATEMENT OF THE CASE

Appellant's invention is directed to an information device, and in particular to obtaining information from a remote location to an information device. Spec. 1. Claim 1, reproduced below, is representative of the claimed subject matter:

> 1. A device for obtaining, storing and displaying information from a data unit via a LAN (Local Area Network) cable, the LAN cable being connected in a building for concurrently carrying a digital data signal and a power signal, the device comprising:
>
> a LAN connector for connecting to the LAN cable;
>
> a LAN transceiver coupled to said LAN connector for transmitting digital data to, and receiving digital data from, the data unit via the LAN cable;
>
> a first memory coupled to said LAN transceiver for storing digital data received from the data unit;
>
> a display coupled to said first memory for displaying information based on data stored in said first memory; and
>
> a single enclosure housing said LAN connector, said LAN transceiver, said first memory and said display,
>
> wherein: said device is addressable in a Local Area Network (LAN) and is operative for communicating with the data unit through the LAN cable for receiving information from the data unit and for storing and displaying the received information;
>
> and said device is at least in part powered by the power signal carried over the LAN cable.

REJECTIONS

Claims 1–6, 9–138, 140–162, and 164–168 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1–4, 7–67, and 73–106 stand rejected under 35 U.S.C. § 102(e) as anticipated by Scannell, Jr. (US 2006/0123053 A1; published June 8, 2006) ("Scannell").

Claims 5, 6, 107–138, 140–162, and 164–168 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Scannell and Schwager et al. (US 2005/0035850 A1; published Feb. 17, 2005) ("Schwager").

Claims 68–72 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Scannell and Chandhok et al. (US 7,263,382 B2; issued Aug. 28, 2007) ("Chandhok").

ANALYSIS

Written Description Rejections

Claim 1

The Examiner finds a "device for obtaining, storing and displaying information from a data unit via a LAN (Local Area Network) cable," as recited in claim 1, lacks written description. Final Act. 2. The Examiner further finds "the specification does not describe in any detail the device communicating with a server over a LAN cable, using a LAN transceiver, and being at least in part powered by the power signal carried over the LAN cable, as recited in [the] claim." Ans. 11.

Appellant contends "it is submitted that ANY ONE of the terms 'Ethernet', 'Structured wiring', 'IEEE 802.3', and 'Local Area Network' expressly, inherently, or implicitly, supports the substitution of the telephone wire pair described in the beginning of the disclosure with a LAN cable as claimed." App. Br. 13; *see e.g.*, Spec. 24. Appellant further argues the Specification describes "[s]uch information may be obtained in various ways using many types of media and communication means. Such communication . . . [including] using networking such as landline telephony, cellular telephony." App. Br. 11–12 (citing Spec. 1, ll. 12–15) (emphasis omitted). Appellant also points to portions of the Specification which state "it will be appreciated that any other type of connection can be used" and "[o]ther telephony connections or any other medium may also be employed." App. Br. 12 (citing Spec. 8, ll. 28–30; 2, ll. 13–16) (emphasis omitted).

We are not persuaded by Appellant's arguments. To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *See, e.g.*, *Moba, B.V. v. Diamond Auto., Inc.*, 325 F.3d 1306, 1319 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 1563 (Fed. Cir. 1991). "[T]he test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art," where "the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed." *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). The exact level of detail

required depends upon "the nature and scope of the claims and on the complexity and predictability of the relevant technology." *Id.* Factors for "evaluating the adequacy of the disclosure" may include "'the existing knowledge in the particular field, the extent and content of the prior art, the maturity of the science or technology, [and] the predictability of the aspect at issue.'" *Id.* (quoting *Capon v. Eshhar*, 418 F.3d 1349, 1359 (Fed. Cir. 2005).

Initially, we find the broad, catch-all provisions describing "[o]ther telephony connections *or any other medium* may also be employed" (Spec. 2, ll. 15–16 (emphasis added)) or "any other type of connection can be used" (Spec. 8, ll. 28–29) do not persuasively indicate that Appellant was in possession of an invention covering communication between the device and a data unit over a LAN cable, where the device included a LAN connector for connecting to the LAN cable, a LAN transceiver coupled to the LAN connector, and the LAN cable being concurrently connected in a building for concurrently carrying a digital data signal and a power signal.

Aside from such catch-all provisions, Appellant's disclosure is generally directed to communications via PSTN (public switched telephone network) by a dial up modem or cellular network, where the device may be connected to a telephone outlet, and may be powered by regular AC power, batteries, or by extracting power from the telephone connection. Spec. 2–3, Summary of the Invention; *see e.g.*, Fig. 1; Spec. 6, ll. 21–23 ("[t]he information device **10** shown comprises a dial-up modem **15** for connecting the information device **10** to a remote location over the PSTN . . .[, t]he dial-up modem **15** connects to a telephone outlet **24** by telephone plug **22** via cable **21** . . . [t]he information device **10** is powered by the local AC power";

Fig. 3; Spec. 7, l. 30 – 8, l. 2 "[e]ach such information device, such as device **10a**, connects to the PSTN **31** (via its dial up modem **15**, cable **21** and telephone connector **22** shown in Figure 1"); Fig. 4; Spec. 8, ll. 19–21 ("information device **10b** (for example) communicates via the PSTN network **31** with the dial up modem **15a**, thus creating a communication link **41**"); Fig. 5; Spec. 8, ll. 22–25 ("the information device **10** directly connects to multiple providers . . . [d]edicated information servers **32b**, **32c** and **32d** are connected to the PSTN **31** via respectively dial up modems **15b**, **15c** and **15d**").

The sole place in the original Specification where a Local area network (LAN) is mentioned occurs on page 24, lines 13–28:

> While the invention has been so far described with respect to modem embedded within the information device **10** which connects directly to the remote server **32**, it will be appreciated that such external connection (either narrow or broad-band, Local- or Wide area network) may be shared with other networked appliances over a home network. As known in the art, in such a configuration a single device, commonly known as Residential Gateway connects to the external connection, whereby multiple in-home appliances share this external pipe by means of an in-home network. Home networks may use dedicated wiring commonly known as 'structured wiring' and employing Ethernet IEEE 802.3 protocols. Other implementations involve wireless RF based network such as standardized in IEEE802.11x or BlueTooth. Other alternatives involve using existing wiring structure such as telephone wiring (e.g. HomePNA technology), powerlines (e.g. HomePlug) and CATV wiring. Adapting the information device **10** to support a home network basically requires substituting the dial-up modem **15** with a modem appropriate for the home network media, such as Ethernet transceiver for wired Ethernet network, IEEE802.11x wireless transceiver or HomePlug compliant transceiver.

We agree with the Examiner that this passage describes sharing an external connection with other networked appliances over a local network using a Residential Gateway. Ans. 11. Moreover, we agree with the Examiner that this disclosure does not persuasively indicate that Appellant was in possession of an invention covering communication between the device and a data unit over a LAN cable, where the device included a LAN connector for connecting to the LAN cable, a LAN transceiver coupled to the LAN connector, and the LAN cable being concurrently connected in a building for concurrently carrying a digital data signal and a power signal, as recited in claim 1.

Accordingly, we sustain the Examiner's 35 U.S.C. § 112, first paragraph, 1 rejection of independent claim 1. For the same reasons, we sustain the Examiner's 35 U.S.C. § 112, first paragraph, rejection of claims 2, 3, 5, 6, 9, 10, 13–15, 18, 20–64, 66, 67, 69, 71–73, 75–78, and 168, which were not separately argued.

Claim 4

The Examiner additionally finds "the data unit is a personal computer," as recited in claim 4, lacks written description. Final Act. 2.

Appellant points to page 7, lines 28–30 of the Specification (App. Br. 14), which states "[i]nformation server **32** is *any apparatus (e.g. computer)* storing information and connectable to an information device **10** for transmitting the information thereto." Spec. 7, ll. 28–30 (emphasis added). We agree with Appellant that such disclosure sufficiently indicates Appellant was in possession of a "personal computer," as claimed.

Accordingly, we do not sustain the Examiner's additional 35 U.S.C. § 112, first paragraph, rejection of dependent claim 4.

Claims 11 and 12

The Examiner additionally finds "wherein said display is a digital display" and "wherein said display is an HDTV display," as recited in claims 11 and 12 respectively, lacks written description. Final Act. 3. The Examiner explains "there is no description of the display within the information device as being digital or HDTV." (Final Act. 3).

Appellant points to page 6, lines 16–22 of the Specification (App. Br. 15), which states:

> The display means **13** may be alpha-numeric only or analog video display, and may use technologies such as LCD (Liquid Crystal Display), FED (Field Emission Display[)], or CRT (Cathode Ray Tube) . . . . In many cases, an adaptor (not shown) is required in order to connect the analog display to digital data device. For example, the adaptor may convert to composite video (PAL, NTSC) or S-Video or HDTV signal.

Appellant further argues the Specification "does not limit the display to a specific type of display," "is not limiting to an analog display," and further contend "LCD displays are only digital." App. Br. 16–17 (emphasis omitted); *see also* Reply Br. 5–6.[1]

Claim 1 recites "the device comprising . . . a single enclosure housing said LAN connector, said LAN transceiver, said first memory and said display." As described in the Specification:

[1] There are no page numbers in Appellant's Reply Brief. We therefore designate the cover page of the Reply Brief as "page 1" and subsequent pages seriatim.

> The information device may be housed within a self-contained stand-alone enclosure, or may be integrated with another appliance. In such integration additional functionalities may be integrated added to the shared housing. For example, the communication means may be shared, the display, the control and the information memory or any combination of the above. As such, the information device may be integrated within a telephone set (either landline or cellular), a PDA or a television set.

Spec. 3, ll. 6–12. The display device integration is further described at page 18, lines 12–14 of the Specification, and states "[t]he information device **110** shown in the figure does not comprise any display means **13**, but rather only employ a video adapter **111**, connectable to any external video monitor."

With respect to claim 11, we agree with Appellant that page 6, lines 16–19 of the Specification sufficiently indicates Appellant was in possession of a "digital display."

However, with respect to claim 12, we agree with the Examiner. *See* Ans. 13–14. The only mention of HDTV in the Specification is with respect to use of an adaptor to convert to an HDTV signal. Spec. 6, ll. 21–22. We agree with the Examiner that the adaptors described in the Specification (Spec. 6, ll. 21–22, 18, ll. 12–14, 23, ll. 27–28) refer to connecting the device to an external display. However, claim 1 recites a device with a single enclosure that includes a display, not connection to an external display.

Appellant also argues that the claims were previously rejected on the basis that "it would have been obvious to an artisan of ordinary skill to use a television device or an HDTV display as the display device." App. Br. 18 (emphasis omitted). However, such rejection is not before us; further, it is well settled that a description that merely renders the invention obvious does

not satisfy the written description requirement. *See Ariad*, 598 F.3d at 1352; *see also Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).[2]

Accordingly, we sustain the Examiner's additional 35 U.S.C. § 112, first paragraph, rejection of dependent claim 12. We do not sustain the Examiner's additional 35 U.S.C. § 112, first paragraph, rejection of dependent claim 11.

Claim 16

The Examiner finds "wherein said display is coupled to said first memory via a composite video interface, and the composite video interface is one of a PAL and an NTSC interface," as recited in claim 16, lacks written description. Final Act. 3.

Appellant points to page 7, lines 8 and 9 of the Specification (App. Br. 18), which states "[t]he control unit **14** couples to most or all device components either for getting data and status information, or for controlling / activating the sub-systems."

We are not persuaded by Appellant's arguments and agree with the Examiner. *See* Ans. 14–15. Specifically, the portion of the Specification Appellant relies on describes that the control unit of the information device couples to most or all device components, and describes that the internal display is coupled to memory via the control unit. We are not persuaded

[2] Appellant repeats essentially this same argument with respect to claims 19, 68, 74, 79, and 80. *See* App. Br. 20, 22, 24, 26, 28; *see also* Reply Br. 6–8 (claims 11, 17).

Appellant has sufficiently shown possession of "the display is coupled to said first memory *via a composite video interface* . . . . "

Accordingly, we sustain the Examiner's 35 U.S.C. § 112, first paragraph, rejection of dependent claim 16.

Claim 17

The Examiner finds "a battery, wherein said device is operative to be at least in part powered from said battery, and wherein said battery is a primary or rechargeable battery," as recited in claim 17, lacks written description. Final Act. 3.

Appellant points to several portions of the Specification, which recite "in one or more embodiments the information device **10** is powered by batteries," "[t]he information device may be powered from a regular AC power, batteries," and "such powering apparatuses and methods are applicable to other types of devices." App. Br. 19 (citing Spec. 3, ll. 4–5, 15, ll. 26–28, 17, ll. 3–5) (emphasis omitted).

Although the Specification generally describes a device powered by batteries, we agree with the Examiner (Ans. 16–17) that the Specification does not sufficiently show possession of the embodiment which uses a rechargeable battery with a LAN cable, rather than a telephone line. (*See* Spec. 16 (describing power extracted from the telephone line during an off-hook condition in order to charge the rechargeable battery)).

Accordingly, we sustain the Examiner's 35 U.S.C. § 112, first paragraph, rejection of dependent claim 17.

Claim 19

The Examiner finds "firmware," as recited in claim 19, lacks written description. Final Act. 3.

Appellant argues "[t]he term 'firmware' is known in the art for a software that is not frequently or easily updated ('firm'), and is typically stored in a non-volatile memory to be used as part of an embedded computer system. The specifications explicitly discloses that non-volatile memory may be used (page 6 line 19)." App. Br. 20.

The Specification generally describes that "[t]he memory may be volatile or non-volatile type, such as Flash, DRAM and RAM." Spec. 6, ll. 18–19. We are not persuaded the mere mention of non-volatile memory sufficiently indicates Appellant was in possession of "firmware," as claimed. *See* Ans. 17–18.

Accordingly, we sustain the Examiner's 35 U.S.C. § 112, first paragraph, rejection of dependent claim 19.

Claim 65

The Examiner finds "said device is further operative to store and play digital audio data," as recited in claim 65, lacks written description. Final Act. 4.

Appellant points to page 15, line 7, which states "[i]n addition to the full duplex audio / telephony carried between the device **85** and the base unit . . . " (App. Br. 21). Appellant also argues "video is known to include audio," and point to several other portions of the Specification describing video content. *Id.* (citing Spec. 1, ll. 17–23 (weather forecast) and Spec. 6, ll. 14–22 (describing an "analog video display")).

We agree with the Examiner that the identified disclosure does not sufficiently indicate possession of a device operative to store and play digital audio data. *See* Ans. 18–19. We disagree with Appellant that video necessarily includes audio. For example, the weather forecast Appellant relies upon appears as text data. *See* Spec. Fig. 6a.

Accordingly, we sustain the Examiner's 35 U.S.C. § 112, first paragraph, rejection of dependent claim 65.

Claim 68

The Examiner finds "the communication with the unit via said connector is based on a standard serial digital data bus," as recited in claim 68, lacks written description. Final Act. 4.

Appellant argues "[t]he serial bus disclosed in the specification may also be used to communicate with units external to the device." App. Br. 22.

We agree with the Examiner that the serial bus described in the Specification lacks any description that it may be used to communicate with the data unit. *See* Ans. 20. The Specification merely describes the control unit coupling to the other components in the information device, as discussed above with respect to claim 16, may be serial or shared bus type. Spec. 7, ll. 10–12.

Accordingly, we sustain the Examiner's 35 U.S.C. § 112, first paragraph, rejection of dependent claim 68.

Claim 70

The Examiner finds the device "adapted to mechanically dock, supply power to, and communicate with the handheld unit," as recited in claim 70,

lacks written description because "these embodiments (depicted in Figs. 13-15b) do not include coupling to a LAN cable." Final Act. 4.

Appellant contends "while the disclosure describes in detail a single example, it should not exclude other variants as mentioned." App. Br. 23.

In addition to the reasoning set forth above with respect to claim 1, we agree with the Examiner that the Specification does not sufficiently indicate Appellant was in possession of the claimed invention. *See* Ans. 21.

Accordingly, we sustain the Examiner's 35 U.S.C. § 112, first paragraph, rejection of dependent claim 70.

Claim 74

The Examiner finds "said device is further operative to periodically retrieve and display information from said first memory," as recited in claim 74, lacks written description. Final Act. 4.

Appellant points to page 11, lines 5–6 of the Specification (App. Br. 24), which states "[i]t will be understood that the operation sequence described above results in a periodic automatic device operation to obtain and display information."

We agree with the Examiner that full reading of the referenced portion of the Specification (*see* Spec. 10, l. 28 – 11, l. 9) indicates that the periodic operation to obtain and display information is from the remote server, not from said first memory, as claimed. *See* Ans. 21–22.

Accordingly, we sustain the Examiner's 35 U.S.C. § 112, first paragraph, rejection of dependent claim 74.

Claim 79

The Examiner finds "a digital to analog converter coupled to said first memory for converting digital data stored in said first memory to an analog signal," as recited in claim 79, lacks written description. Final Act. 4.

Appellant points to page 24, line 11, which refers to a "set top box," and 29, line 27, which also refers to a "set top box." App. Br. 25. Appellant also points to page 6, lines 19–22, which states "the adaptor may convert to composite video (PAL, NTSC) or S-Video or HDTV signal". *Id.*

We agree with the Examiner that the Specification at page 6 refers to an analog to digital converter, not the claimed digital to analog converter. *See* Ans. 23. In addition, the references to the "set top box" in the Specification describe embodiments where a television set is used for displaying the video, which as discussed above with respect to claims 11 and 12, does not describe the embodiment recited in claim 1 (from which claim 79 depends). Therefore, we agree with the Examiner that the Specification does not sufficiently indicate Appellant was in possession of the claimed "digital to analog converter." *See* Ans. 23.

Accordingly, we sustain the Examiner's 35 U.S.C. § 112, first paragraph, of dependent claim 79.

Claims 80–81

The Examiner finds "an analog video signal," as recited in claims 80 and 81, lacks written description because, in the Specification, "the information received by Applicant's information device **10** is not a video signal, but rather information content of a limited size." Final Act. 5 (emphasis added); see also Fig. 6A; Spec. 12, ll. 12–16.

Appellant points to page 31, lines 27–28 of the Specification, which states "the information transported as part of the present invention may be of any type." App. Br. 27 (emphasis omitted). Appellant further contends video content is not excluded, and points to the description of a weather forecast at page 1, lines 17–23. *Id.* Appellant also cites to page 6, lines 14–22 of the Specification, which states the display means may be "analog video display." *Id.* (emphasis omitted). Appellant points to page 24, lines 5–6, which describes "[t]he splitter/combiner 114 combines the video signal from the information device 170." *Id.* at 28 (emphasis omitted). Appellant also argues an "image" is disclosed at page 2, line 1, page 32, line 5, and page 31, line 23, and "video is essentially a sequence of images." *Id.*

For the reasons set forth by the Examiner, we agree with the Examiner that Appellant has not sufficiently shown possession of an "analog video signal," as recited in the claims. *See* Ans. 23–27. That the display may be an "analog video display" does not necessarily mean an "analog video signal" is received. In addition, we agree with the Examiner that the list of information provided at page 12 of the Specification does not refer to any video content.

Accordingly, we sustain the Examiner's 35 U.S.C. § 112, first paragraph, rejection of dependent claims 80 and 81.

Claim 82

The Examiner finds a "device for communicating with a data unit over a point-to-point cable connected to simultaneously carry a DC power signal and a half-duplex serial digital data signal" and "wherein said first transceiver and said first non-volatile memory are coupled to said first

connector to be powered from the DC power signal," as recited in claim 82, lacks written description. Final Act. 5.

Appellant points to page 2, lines 18–19 of the Specification, which states "[t]he communication may be direct point-to-point connection (such as in telephony) or via the Internet," and also relies on the similar catch-all statements as with respect to claim 1. App. Br. 29.

For the same reasons as set forth above with respect to claim 1, as well as the reasons set forth by the Examiner (Ans. 27–28), we agree with the Examiner that this disclosure does not persuasively indicate that Appellant was in possession of an invention covering communication between the device and a data unit over a point-to-point cable connected to simultaneously carry a DC power signal and a half-duplex serial digital data signal and where a first transceiver and a first non-volatile memory are coupled to a first connector to be powered from the DC power signal, as recited in claim 82.

Accordingly, we sustain the Examiner's 35 U.S.C. § 112, first paragraph, rejection of independent claim 82. For the same reasons, we sustain the Examiner's 35 U.S.C. § 112, first paragraph, rejection of dependent claims 83–138, and 140—162, and 164–167, which were not separately argued.

Anticipation and Obviousness Rejections

Appellant contends "this application is entitled to the priority date of January 13, 2004 because the present claims are supported by the disclosure of that priority application." App. Br. 8. Appellant argues "upon reversal of the [written description rejection], the prior art rejection must also be

reversed" because the "references [have] prior art dates later than the priority date of the parent foreign application." *Id.*

Because all claims remain subject to rejections under 35 U.S.C. § 112, first paragraph, we need not reach this issue. Accordingly, we summarily sustain the Examiner's 35 U.S.C. § 102(e) rejection of claims 1–4, 7–67, and 73–106 and summarily sustain the Examiner's 35 U.S.C. § 103(a) rejections of claims 5, 6, 68–72, 107–138, 140–162, and 164–168.

DECISION

The Examiner's 35 U.S.C. § 112, first paragraph, rejection of claims 1–6, 9–138, 140–162, and 164–168 is affirmed.

The Examiner's additional and separate 35 U.S.C. § 112, first paragraph, rejections of claims 4 and 11 are reversed.

The Examiner's 35 U.S.C. § 102(e) rejection of claims 1–4, 7–67, and 73–106 is summarily affirmed.

The Examiner's 35 U.S.C. § 103(a) rejections of claims 5, 6, 68–72, 107–138, 140–162, and 164–168 are summarily affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED